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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,631	08/16/2001	Quintin T. Phillips	10007611-1	6321

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HEWLETT-PACKARD COMPANY
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EXAMINER

ROBINSON, MYLES D

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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10/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/932,631

Applicant(s)

PHILLIPS ET AL.

Examiner

Myles D. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 - 16, 24, 26 and 30 - 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 16, 24, 30, 32, 37, 39 and 40 is/are rejected.
- 7) ☒ Claim(s) 26, 31, 34 - 36 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Applicant's brief was received on 5/14/2007, and has been entered and made of record. Currently, **claims 1, 3 – 16, 24, 26 and 30 – 40** are pending.

Response to Arguments

2. Applicant's arguments (*see Appeal Brief 5/14/2007*) with respect to **claims 1, 3 – 16, 24, 26 and 30 – 40** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. **Claims 1, 3 – 16, 24, 30, 32, 33, 37, 39 and 40** are rejected under 35 U.S.C. 102(e) as being anticipated by **Pauschinger et al.** (U.S. Patent No. 6,978,255).

Referring to **claim 9**, Pauschinger discloses a consumable monitoring system comprising:

a database (*see Fig. 1, data center 100, data bank 110*) configured to store information regarding a plurality of consumables usable to form hard images (*see Fig. 1, thermal transfer inking ribbon cassette 9 [column 6, lines 36 – 41]*), wherein the stored

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information for an individual one of the consumables includes a stored consumable identifier which identifies the respective consumable (*column 4, lines 7 – 10 wherein the code word identifying a specific consumable is stored within data bank 110 and column 4, lines 18 – 21 wherein the group of code words stored within data bank 110 is analogous to information regarding a plurality of consumables*), and a stored party identifier utilized to identify a proper party associated with the respective consumable (*column 3, lines 60 – 64 wherein the consumable is associated with and recognized by an identifier [i.e. code word] of the authorized manufacturer of the consumable*),

an interface (*see Figs. 1 and 2 wherein postage meter machine 1 is connected to data center 100 and data bank 110 via data connection 14 using a modem 13*) adapted to receive information regarding a consumable to be verified including a received consumable identifier which identifies the consumable to be verified and a received party identifier utilized to identify the proper party associated with the consumable to be verified (*column 1, lines 17 – 20, column 6, line 63 – column 7, line 2, column 8, lines 42 – 44 and 46 – 55*),

processing circuitry (*see Fig. 2, microcomputer 19, data center 100 [column 11, lines 65 – 67]*) configured to compare the received consumable identifier with the stored consumable identifiers (*column 4, lines 18 – 31*) and to compare the received party identifier with the stored party identifier of a respective one of the consumables corresponding to the received consumable identifier (*column 3, line 50 – column 4, line 31 wherein the data center 100 prevents the use on “unallowed consumables” from non-authorized manufacturers by authenticating whether the consumable is from a*

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properly authorized manufacturer, based upon the transmitted reference code word specific to the consumable, such that an inherent comparison must be made between the received consumable's code word identifying its manufacturer and the stored code words of consumables within data bank 110 in order to determine counterfeiting), and wherein the processing circuitry is configured to control outputting of a communication responsive to the received party identifier not matching the stored party identifier of the respective consumable (column 3, lines 51 – 56 wherein the definition of “unallowed consumables” as those pirated products from other manufacturers is analogous to consumables of unauthorized parties) and wherein the communication indicates the failure of the received party identifier to match the stored party identifier of the respective consumable (see Figs. 1 and 2 wherein a message is displayed on user interface 4 [column 4, lines 38 – 40, 43 – 45, 49 – 55, column 5, lines 25 – 34 and 41 – 49] and see column 3, lines 7 – 20, column 10, lines 39 – 43 and 62 – 67 wherein various notification methods are utilized to communicate detection of an unauthorized consumable and even the source of the offense, such methods including notifications on the manufacturer's end as well as the unauthorized user's end).

Referring to **claim 10**, Pauschinger discloses the system further wherein the processing circuitry is configured to forward the communication comprising a message to the proper party associated with the respective consumable responsive to the comparisons (column 3, lines 7 – 20, column 10, lines 39 – 43 and 62 – 67 wherein various notification methods are utilized to communicate detection of an unauthorized

consumable and even the source of the offense, such methods including notifications on the manufacturer's end as well as the unauthorized user's end).

Referring to **claim 11**, Pauschinger discloses the system further wherein the processing circuitry is configured to forward the communication comprising a command to disable at least one operation of an image forming device coupled with the consumable to be verified responsive to the comparison (*column 10, lines 39 – 43 and column 11, lines 39 – 58*).

Referring to **claim 12**, Pauschinger discloses the system further wherein the processing circuitry is configured to forward the communication comprising a warning message to an image forming device coupled with the consumable to be verified responsive to the comparison (*see Figs. 1 and 2 wherein a message is displayed on user interface 4 [column 4, lines 38 – 40, 43 – 45, 49 – 55, column 5, lines 25 – 34 and 41 – 49]*).

Referring to **claim 13**, Pauschinger discloses the system further comprising a memory device, and wherein the processing circuitry is configured to forward the received consumable identifier, the received party identifier, and date and time information regarding the reception of the received consumable identifier and the received party identifier to the memory device for storage (*column 2, lines 44 – 61 wherein the data center inherently stores the date and time at which the consumable was installed in order to determine time limits for regeneration of the specific consumables' reference codes in order to prevent unauthorized use*).

Referring to **claim 14**, Pauschinger discloses the system further wherein the interface is adapted to receive the information regarding the consumable to be verified including the received party identifier comprising a received device identifier which identifies the image forming device which communicated the information and wherein the database is configured to store the stored party Identifiers comprising at least one stored device identifier which identifies an image forming device associated with the proper party for the respective consumable and wherein the processing circuitry is configured to compare the received device identifier with the stored device identifier to compare the received party identifier with the stored party identifier (*column 3, lines 7 – 20, column 10, lines 39 – 43 and 62 – 67 wherein various notification methods are utilized to communicate detection of an unauthorized consumable and the source [i.e. image forming device] of the offense*).

Referring to **claim 15**, Pauschinger discloses the system further wherein the database is configured to store the stored party identifier comprising a plurality of stored device identifiers which identify a plurality of image forming devices associated with the proper party of the respective consumable, and wherein the processing circuitry is configured to compare the received party identifier comprising a received device identifier with the stored device identifiers (*column 3, line 50 – column 4, line 31 wherein the data center 100 prevents the use on “unallowed consumables” from non-authorized manufacturers by authenticating whether the consumable is from a properly authorized manufacturer, based upon the transmitted reference code word specific to the consumable, such that an inherent comparison must be made between the received*

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consumable's code word identifying its manufacturer and the stored code words of consumables within data bank 110 in order to determine counterfeiting).

Referring to **claim 16**, Pauschinger discloses the system further wherein the interface is adapted to receive the information regarding the consumable to be verified including the received party identifier which directly identifies the proper party of the respective consumable (*column 3, line 50 – column 4, line 31 wherein the data center 100 prevents the use on "unallowed consumables" from non-authorized manufacturers by authenticating whether the consumable is from a properly authorized manufacturer, based upon the transmitted reference code word specific to the consumable, such that an inherent comparison must be made between the received consumable's code word identifying its manufacturer and the stored code words of consumables within data bank 110 in order to determine counterfeiting).*

Referring to **claim 32**, Pauschinger discloses the system further wherein the communication indicates use of the consumable to be verified by an unauthorized party (*column 3, line 50 – column 4, line 31 wherein the data center 100 prevents the use on "unallowed consumables" from non-authorized manufacturers by authenticating whether the consumable is from a properly authorized manufacturer, based upon the transmitted reference code word specific to the consumable, such that an inherent comparison must be made between the received consumable's code word identifying its manufacturer and the stored code words of consumables within data bank 110 in order to determine counterfeiting).*

Referring to **claim 33**, Pauschinger discloses the system further wherein the processing circuitry is configured to address the communication for communication to the proper party and to control outputting of another communication comprising a warning message of unauthorized use to an Image forming device coupled with the consumable to be verified (*column 3, line 50 – column 4, line 31 wherein the data center 100 prevents the use on “unallowed consumables” from non-authorized manufacturers by authenticating whether the consumable is from a properly authorized manufacturer, based upon the transmitted reference code word specific to the consumable, such that an inherent comparison must be made between the received consumable’s code word identifying its manufacturer and the stored code words of consumables within data bank 110 in order to determine counterfeiting*).

Referring to **claim 39**, Pauschinger discloses the system further wherein the non-matching received party identifier and the stored party identifier identify different parties (*column 3, line 50 – column 4, line 31 wherein the data center 100 prevents the use on “unallowed consumables” from non-authorized manufacturers by authenticating whether the consumable is from a properly authorized manufacturer, based upon the transmitted reference code word specific to the consumable, such that an inherent comparison must be made between the received consumable’s code word identifying its manufacturer and the stored code words of consumables within data bank 110 in order to determine counterfeiting*). In other words, the inherent comparison taught by Pauschinger yields the identification of different manufacturers (i.e. different parties) in the process of

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detecting counterfeit consumables based upon the comparison between data received from said consumables and those data stored in the data bank 110.

Referring to **claim 40**, Pauschinger discloses the system further wherein the processing circuitry is configured to communicate the communication to the proper party and wherein the communication comprises the received party identifier corresponding to an unauthorized party different than the proper party (*column 10, lines 39 – 43 and 62 – 67 wherein the manufacturer at the data center [i.e. proper party] is able to identify customers whom are repeat offenders and those sources from which these offenders probably obtained a valid code word*).

Referring to **claims 1, 24 and 3 – 8**, the rationale provided in the rejections of claims 9 – 16, respectively, are incorporated herein. In addition, the systems of claims 9 – 16 perform the methods of claims 1, 24 and 3 – 8, respectively.

Referring to **claim 30**, Pauschinger discloses the method further wherein the message indicates the failure of the received party identifier to match any stored party Identifier associated with the consumable to be verified (*column 3, line 50 – column 4, line 31 wherein the data center 100 prevents the use on “unallowed consumables” from non-authorized manufacturers by authenticating whether the consumable is from a properly authorized manufacturer, based upon the transmitted reference code word specific to the consumable, such that an inherent comparison must be made between the received consumable’s code word identifying its manufacturer and the stored code words of consumables within data bank 110 in order to determine counterfeiting*).

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Referring to **claim 37**, Pauschinger discloses the method further wherein the proper party is entitled to use the consumable to be verified and the unauthorized party is a party different than the proper party (*column 10, lines 39 – 43 and column 11, lines 39 – 58*).

Allowable Subject Matter

5. **Claims 26, 31, 34 – 36 and 38** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Referring to **claims 26, 34 and 38**, although the Applicant discloses that an alternative sequence of comparisons is possible wherein the sequence of comparisons does not effect the intended results and wherein the particular sequence of **first** comparing the consumable identifiers and then comparing the party identifiers **second** has no disclosed benefit or advantage (*see Specification [page 14, lines 21 - 30]*), the innovative limitation that distinguishes the Applicant's claim is comparing the received consumable identifier with the stored consumable identifier **before** the comparison of the received party identifier with the stored party identifier.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Diab et al. (U.S. Patent No. 7,234,061) disclose a method for verifying modules from approved vendors (*see Abstract and Figs. 3 – 5*).

Matsushita et al. (U.S. Patent No. 5,132,729) disclose genuine security article distinguishing system for an image forming apparatus wherein the manufacturer code of the component part can be compared with the stored manufacturer code and a determination can be made as to whether the product is authentic (*see Abstract and Figs. 4(a) and 5*).

Hirst et al. (U.S. Patent No. 5,930,553) disclose an image forming and office automation device consumable with memory storing information (*see Abstract and Figs. 2 and 4 – 6*).

Walker et al. (U.S. Patent No. 6,494,562) disclose a method for identifying a sales channel wherein a replaceable printing component is of the type sold through a plurality of sales channels and uses a radio frequency link for receiving information indicative of a particular sales channel of a plurality of sales channels (*see Abstract and Figs. 2, 4 and 5*).

Ono (U.S. Patent No. 7,177,553) discloses a part determination device that determines whether or not a replacement part is an approved part based on information acquired identifying the replacement part and registers individual identification information if in the event it has been determined that the replacement part is not an approved part (*see Abstract and Figs. 1 – 5*).

Schneider et al. (U.S. Patent No. 7,099,028) discloses a method for providing restricted web site access to users of certain brands of printing device replaceable components (*see Abstract and Figs. 3 – 4*).

Miyaji (U.S. Patent No. 7,231,166) discloses a consumable goods management system (*see Abstract and Fig. 4*).

Takemoto (U.S. Patent No. 6,625,402) discloses an information service server, which manages a home page that provides information about an image forming cartridge and a printing apparatus using the cartridge, and a printing system are connected to each other via a network wherein the cartridge includes nonvolatile memory that stores information which gains access to the home page and identifies the cartridge as a genuine product (*see Abstract and see Fig. 4*).

Asakura (U.S. Pre-Grant Publication No. 2003/0031475) discloses a process unit identification method of an image forming apparatus (*see Abstract and Fig. 5*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571) 272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

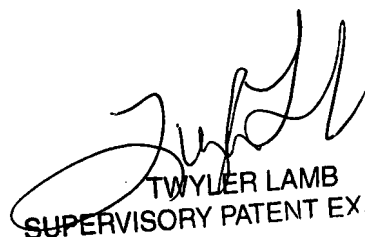
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MDR

10/16/07



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SUPERVISORY PATENT EXAMINER